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| APPLICATION NO.               | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------|-------------|----------------------|---------------------|------------------|
| 09/463,033                    | 07/16/2000  | GAVIN ROBERT FERRIS  | P/2985-22           | 5787             |
| 2352                          | 7590        | 04/23/2004           | EXAMINER            |                  |
| OSTROLENK FABER GERB & SOFFEN |             |                      | CHUNG, JASON J.     |                  |
| 1180 AVENUE OF THE AMERICAS   |             |                      | ART UNIT            | PAPER NUMBER     |
| NEW YORK, NY 100368403        |             |                      | 2611                |                  |
| DATE MAILED: 04/23/2004       |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|------------------------------|------------------------|---------------------|
|                              | 09/463,033             | FERRIS ET AL.       |
| <b>Examiner</b>              | <b>Art Unit</b>        |                     |
| Jason J. Chung               | 2611                   |                     |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1-2448-2000-0

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 18 January 2000.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-32 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-32 is/are rejected.  
7)  Claim(s) 1,5,16,18-23,26 and 31 is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All    b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors, which are probably due to the differences in language from the United Kingdom to the United States. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claim Objections*

2. Claim 18 is objected to because of the following informalities: line 2 states "the encoded authorisation signal". There is no antecedence for "encoded authorisation signal" and authorisation should be spelled authorization. The examiner interprets line 2 to state, "an encoded authorization signal". Appropriate correction is required.

Claims 1, 5, 26 are objected to because of the following informalities: they state "a user". The claims should state "an user". The examiner interprets the claims to state, "an user". Appropriate correction is required.

Claim 19 is objected to because of the following informalities: line 1 states "the security means". There is no antecedence for "security means". The examiner interprets line 2 to state, "a security means". Appropriate correction is required.

Claims 16, 20-23, 26, and 31 are objected to because of the following informalities: they state "authorisation" or "synchronisation". The spelling for "authorisation" and "synchronisation" should be spelled authorization and synchronization. The examiner interprets line 2 to state, "an encoded authorization signal". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 5-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldstein (US Patent # 5,410,326).

Regarding claim 1, Goldstein discloses the menu displayed on the remote control shows a television icon that indicates that the selected mode is in television reception (column 9, lines 3-14). Goldstein discloses advertisements can be downloaded to the remote control (column 11, lines 15-26), which meets the limitation on determining whether a broadcast receiver is receiving a particular channel, the apparatus further comprising receiving means for receiving a signal, means for displaying information in response to a signal received by the receiving means. Goldstein discloses the user can order items by sending a command over a telephone link (column 11, line 44-column 12, line 12). Goldstein discloses data accompanying an advertisement may be captured by a user (column 14, lines 2-20). Goldstein discloses the user can call the sponsoring party and receive further information on a product being advertised (column 14, lines 42-55). Goldstein discloses the user can communicate use the remote control and place orders for products (column 28, line 59-column 29, line 64). Goldstein discloses the information is sent in a telephone call (column 29, line 65-column 30, line 32), which meets the limitation on means responsive to a user input to provide an outgoing signal and transmitting

means for transmitting the outgoing signal, wherein at least one of the receiving means and the transmitting means is for communicating by radio with a remote station responsive to outgoing signals from a plurality of communications apparatus. Goldstein discloses information can be sent over a radio antenna telephone (column 17, lines 23-31), which meets the limitation on communicating by radio.

Regarding claim 5, Goldstein discloses when the user selection is made by touching the icon on the screen, the remote control will signal the telephone interface 5 to establish a call with the vendor (column 11, lines 44-66), which meets the limitation on transmitting the outgoing signal as soon as the user input is complete.

Regarding claim 6, Goldstein discloses remote control is shown in figure 10 (column 12, lines 13-22). Goldstein discloses the program origination facility to transmit signals to the cable converter and the cable converter transmits signals to the remote control via links 30,31 (column 12, lines 23-33), which meets the limitation on receiving a signal from a broadcast receiver.

Regarding claim 7, Goldstein discloses the broadcasts carrying data could be accompanied by a visual or audio indication and the indication can be a displayed icon or audio signal heard by the user (column 14, lines 3-20), which meets the limitation on displaying information is arranged to display information immediately in response to a signal received by the receiving means.

Regarding claims 8-9, Goldstein discloses the RAM 90 stores the information that includes the date, time and channel number of the broadcast (column 14, lines 21-35). Goldstein discloses using the bi-directional communications link, the set top box can be setup to record a future broadcast and information such as phone numbers may be displayed (column 14, lines 36-

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55), which meets the limitation on storing a signal received by the receiving means and having a time comparison means for controlling display of information in response to a stored signal at a predetermined time.

Regarding claims 10, 11, as disclosed in claim 1 rejection Goldstein discloses a remote control.

Regarding claim 12, Goldstein discloses the remote control has a display that includes icons (column 7, lines 4-41). Goldstein discloses the remote control uses infrared command to select channels (column 9, lines 15-17). Goldstein discloses the arrows 60, 62 (figure 2C) of the remote control controls channel selection (column 9, lines 56-66), which meets the limitation on responsive to alter the information displayed in response to a channel selected using the remote control.

Regarding claim 13, Goldstein discloses the ads can be received by set top 6 and sent to the remote control (column 11, lines 15-26). Goldstein discloses mail can be displayed on a remote control and also on the television screen (column 11, lines 27-43), which meets the limitation on determining whether a broadcast receiver is receiving a particular channel comprises receiving a signal from the broadcast receiver and comparing this signal with a signal received from the receiving means.

Regarding claim 14, Goldstein discloses the features of the remote control (column 13, line 58-column 14, line 2; figure 11). Goldstein discloses when an ad is being transmitted with data, the user can press button 101 on the remote control to capture the information to the remote control (column 14, lines 3-20), which meets the limitation on determining whether a broadcast receiver is receiving a particular channel comprises receiving a signal from a remote control.

Regarding claim 15, Goldstein discloses the remote control has a display that includes icons (column 7, lines 4-41). Goldstein discloses the remote control uses infrared command to select channels (column 9, lines 15-17). Goldstein discloses the arrows 60, 62 (figure 2C) of the remote control controls channel selection (column 9, lines 56-66), which meets the limitation on displaying information is further responsive to the user input.

Regarding claim 16, Goldstein discloses the information with a customers order requires a pin number (column 31, lines 39-45). Goldstein discloses the pin number is transmitted to the vendor (column 31, lines 46-62), which meets the limitation on transmitting an encoded authorization signal.

Regarding claims 17, 18, Goldstein discloses the user can provide transaction history to a marketing research center (column 27, lines 19-51). Goldstein discloses the event history is stored in a memory (column 27, line 60-column 28, line 5). Goldstein discloses the customer sends the information to a marketing research company after entering a pin number on the remote control and authorizing the transfer (column 28, lines 6-28), which meets the limitation on a security means responsive to a predetermined used input for preventing the transmission of at least part of an outbound signal if the predetermined user input is not correctly provided and the outbound signal is a encoded authorization signal.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 20-23, 26, 27, 30, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein (US Patent # 5,410,326) in view of Budow (US Patent # 5,661,517).

Regarding claim 2, Goldstein is silent on the remote station is distinct from the primary station. Budow discloses databases 7-10 (column 8, lines 52-62; figure 1). Budow discloses the headend is comprises of signal receivers and redistributes the signals to the users (column 8, line 63-column 9, line 13). Budow discloses the system computer 4 can connect to the appropriate databases 7-10 for completion of the transaction (column 10, line 57-column 11, line 23), which meets the limitation on the remote station is distinct from the primary station. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Goldstein to have the remote station be distinct from the primary station as taught by Budow in order to provide system versatility in the event that the user has an unique card that must connect with the appropriate financial database located in a remote location.

Regarding claims 20-21, the limitations in claim 20 have been met in claims 1, 2, rejections by the combination of Goldstein and Budow. Goldstein discloses the set top converter may be configured with a future broadcast to be certain to be turned on at the appropriate time and tuned to the appropriate channel to permit a recording of the future broadcast (column 14, lines 36-41). Goldstein discloses in a further embodiment, the data includes a digitizer for telephone digits will place a call forwarded to the cable converter and call the sponsoring party to obtain additional information on the product being advertised (column 14, lines 42-55), which meets the limitation on synchronizing the transmission of information to at least one transmission from the primary broadcaster and storing timing data associated with the

information and the means for synchronizing the transmission of information is responsive to the stored timing data.

Regarding claim 22, Goldstein discloses in a further embodiment, the data includes a digitizer for telephone digits will place a call forwarded to the cable converter and call the sponsoring party to obtain additional information on the product being advertised (column 14, lines 42-55), which meets the limitation on transmitting the information before an intended time and to transmit cueing information.

As previously disclosed, Goldstein discloses additional information is sent to the user on the product being advertised. Neither Goldstein nor Budow discloses the additional information is displayed. The examiner takes Official Notice that information sent from a sponsoring party to the user being displayed is notoriously well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Goldstein in view of Budow to have the additional information sent back to the user be displayed in order to provide the user with a visual description of the product.

Regarding claim 23, Goldstein discloses ads transmitted with additional information (column 14, lines 3-20). Goldstein discloses in a further embodiment, the data includes a digitizer for telephone digits will place a call forwarded to the cable converter and call the sponsoring party to obtain additional information on the product being advertised (column 14, lines 42-55), which meets the limitation on responsive to at least one portion of the signal from the primary broadcaster.

Regarding claim 26-27, the limitations in claim 26 have been met in claim 20-21 rejections. Goldstein discloses in a further embodiment, the data includes a digitizer for

telephone digits will place a call forwarded to the cable converter and call the sponsoring party and the sponsoring party obtains the user's address for receiving additional information to obtain additional information on the product being advertised (column 14, lines 42-55), which meets the limitation on apparatus comprising receiving means for receiving a signal from the transmitter apparatus, means for using information in response to a signal received by the receiving means, means responsive to a user input to provide an outgoing signal and transmitting means for transmitting the outgoing signal; the signal being sent back to the user meets the limitation on receiving apparatus for receiving the outgoing signal.

As previously disclosed, Goldstein discloses the caller ID, but neither Goldstein nor Budow discloses the caller ID displaying the user's location and the receiving apparatus storing the information for subsequent processing. The examiner takes Official Notice that caller ID displaying a user location and sending information back to the user via an electronic return path are notoriously well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Goldstein in view of Budow to have the caller ID display the information in order to provide a display of the location to a troubleshooter at the sponsoring party thereby verifying the equipment is working. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Goldstein in view of Budow to have the information returned via an electronic return path in order to provide the user a display of the additional information or an audio description of additional information.

Regarding claim 30, the limitations in claim 30 have been met in claim 7 rejection.

Regarding claim 31, the limitations in claim 31 have been met in claims 1, 2 rejections.

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5. Claims 3-4, 24, 25, 28, 29, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein in view of Budow in further view of Blair (US Patent # 4,916,728).

Regarding claims 3-4, neither Goldstein nor Budow discloses a system of using a cell of a multi-cell communication system and a paging system. Blair discloses it is familiar to those of ordinary skill in the art that paging channels are used between a cellular telephone and a cell site in setting up a phone call (column 1, lines 41-48; figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Goldstein in view of Budow to have a cell in a multi-cell communication system and a paging system as taught by Blair in order to avoid complicated wiring in a system by using wireless communication.

Regarding claims 24, 25, 28, 29, 32, the limitations in claims 24, 25, 28, 29, 32 have been met in claims 3-4 rejections.

6. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein.

Regarding claim 19, Goldstein discloses the information with a customers order requires a pin number (column 31, lines 39-45). Goldstein discloses the pin number is transmitted to the vendor (column 31, lines 46-62), which meets the limitation on transmitting an encoded authorization signal. Goldstein fails to disclose the pin number is a plurality of different predetermined user inputs. The examiner takes Official Notice that a pin number with a plurality of numbers is notoriously well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Goldstein to have a pin number include a plurality of different numbers in order to have more security measures by making it harder to guess the pin number.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason J. Chung whose telephone number is (703) 305-7362. The examiner can normally be reached on M-F, 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JJC



VIVEK SRIVASTAVA  
PRIMARY EXAMINER